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UNITED STATES DEPARTMENT OF COMMERCE

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SM

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/054,602 04/03/98 SMITH

D 74311ACFR

001333
PATENT LEGAL STAFF
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IM22/0521

EXAMINER

REDDICK, M

ART UNIT

PAPER NUMBER

13

1713

DATE MAILED:

05/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Applicant No.

09/054,602

Applicant(s)

SMITH ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/01/01 & 03/05/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 11-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 11-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Continued Prosecution Application

- 1. The request filed on 03/01/00 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/054,602 is acceptable and a CPA has been established. An action on the CPA follows.***

Claim Rejections - 35 USC § 112

- 2. The following is a quotation of the second paragraph of 35 U.S.C. 112:***

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 3. Claims 1-5 and 11-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.***

- A) In claim 1, line 9, "an" should be inserted before "effective" so as to engender claim language clarity.***
- B) The recited "methacrylic acid" per claim 3 constitutes indefinite subject matter as per the non-express establishment of proper antecedent basis.***
- C) The recited "salts" per claim 5 should read "salt", i.e., the plural form of salt should be recited in the singular form so as to engender claim language consistency.***
- D) The recited "resinous polymers" per claim 24 constitutes indefinite subject matter as per the metes and bounds of such engendering an indeterminacy in scope. Further the phrase houses redundant subject matter.***

Claim Rejections - 35 USC § 103

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-5 and 11-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over McNeil (U.S. 5,089,295) as per reasons clearly set forth in the previous Office Action per paper no. 7, 04/11/00, paragraph no. 5.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5 and 11-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Utsumi et al (U.S. 5,002,847).

Utsumi et al disclose and exemplify toner particles produced via, basically, suspension polymerizing addition, polymerizable, ethylenically unsaturated monomers which include styrene and derivatives thereof, carboxyl group-containing monomers such as (meth)acrylic acid, x-linking monomers such as divinyl benzene, etc. in the presence of a coloring agent, 0.1 to 50 wt.% of a suspension stabilizer combination which includes an organic/inorganic compound combination and includes colloidal silica, cellulose compounds, starches, lithium phosphate, talc, etc., a polymeric component governed by a MW of 600 to 500,000, a surface active agent and other conventional additives. See, e.g., the Abstract, cols. 2-9 and the Runs of Utsumi et al. Utsumi et al therefore anticipate the instantly claimed invention, in both content and character with the understanding that the components of Utsumi et al clearly overlap in scope with the components per the claimed invention.

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

10. Claims 1-5 and 11-25 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kamiyama et al (U.S. 6,140,394).

Kamiyama et al disclose and exemplify methods of suspension polymerizing a monomer mixture which includes (meth)acrylic acid and derivatives thereof, styrene and derivatives thereof, etc. in the presence of suspension stabilizers which include polyvinyl alcohol, cellulose compounds, starch, fine silica powder, etc., suspension stabilizer aids such as sodium chloride or sulfate, pigments and other conventional additives. See, e.g., the Abstract, cols. 6, 9 and 10 and the Runs of Kamiyama et al. Kamiyama et al therefore anticipate the instantly claimed invention, in both content and character with the understanding that the components of Kamiyama et al overlap in scope with the claimed components.

Response to Arguments

11. Applicant's arguments filed 03/01/01 have been fully considered but they are not persuasive.

Relative to McNeil-It is urged and maintained that the instantly claimed invention is obvious within the meaning of 35 USC 103 over McNeil as per reasons of record.

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The crux of Counsel's arguments appears to hinge on the non-specific disclosure directed to the use of at least 20 wt.% of a carboxylic acid monomer in the dispersed phase of the suspension polymerization process of McNeil. With all due respect to counsel's opinion, the Runs of McNeil house 42 wt.% of n-butyl methacrylate, disclosed (col. 11, lines 46-67) as an equivalent to the claimed carboxylic acid monomer. To this end, one having ordinary skill in the art would have readily envisioned the swap of the carboxylic acid monomer, viz., acrylic acid, for the exemplified n-butyl methacrylate or the butadiene, for that matter, with the understanding that 1-99 wt.% of the monomers are authorized (col. 11, lines 46-50) and with a reasonable expectation of success. Criticality for such clearly commensurate in scope with the claims, not having been demonstrated on this record. The resinous polymer is a moot issue since claims 24 and 25 were not rejected over McNeil.

Relative to the 112 issues--While Counsel, in a good faith effort, attempted to remedy the 112 issues raised in a previous Office Action, at least one 112 issue remains and new issues were created and/or newly discovered and are as set forth supra.

Conclusion

12. The additional prior art made of record and not relied upon is considered illustrative of the general state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone

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number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

J. M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
May 18, 2001